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10/586,922	07/24/2006	Atsushi Matsutani	292901US8PCT	8179
22850 7590 02/19/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER ROBINSON, GRETA LEE				
ART UNIT		PAPER NUMBER		
2169				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/586,922

Applicant(s)

MATSUTANI, ATSUSHI

Examiner

Greta L. Robinson

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2009 has been entered.
2. Claims 1, 2, 4-8 and 10-15 are pending in the present application.
3. Claims 1, 4, 5-7 and 12 have been amended. Claims 3 and 9 have status cancelled.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "hardware communication unit" or hardware does not appear to be used in the disclosure.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-2, 4-6, 14 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The specification provides evidence at page 43 lines 17-27, that the "program search system" is not limited to hardware elements. If all elements would have been reasonably interpreted in light of the disclosure by one of ordinary skill as software alone, the claim is directed to software *per se* and is non-statutory.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6, 12, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: regarding independent claim 1, the claim omits a search operation. Also, independent claim 12 omits a search process. Claims 2-6, 14 and 15 are rejected based on dependency.

9. Claims 1, 2, 4-6, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 1, the following limitation is vague and/or not clear: "appearance frequency of said keyword as a search result" [see: claim 1 lines 7-11]. The claim does not specifically state a search process is executed with the body of the claim. The phrase "keyword as a search result" is unclear. Claims 2, 4-6, 14 and 15 are rejected based on dependency.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 4-8 and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanemitsu et al. US Patent 6,928,262 B1.

Regarding claim 1, **Kanemitsu** teaches a program search system [note: "A broadcast receiving device which clearly indicates supplemental information transmitted along with broadcast content, and which **facilitates program search**" abstract] comprising:

a keyword registration unit configured to register a keyword for showing the user's preference in broadcast programs [note: column 3 line 63 through column 4 line 11 keyword mode switching means provides ability to obtain **registered keywords** for topic information search registered keywords are stored as keywords in keyword storing means; Figures 25-25; col. 3 lines 56-57];

a hardware communication unit configured to receive broadcast content information including the titles of said broadcast programs that will be broadcasted by one or more broadcasting stations [note: Figure 1 (17) input device; and **processor means** column 2 lines 59-67]; and

a detector configured to detect an appearance frequency of said keyword by said broadcast programs, in the broadcast content information received by said hardware communication unit, said detector configured to generate a ranking of said broadcast programs in descending order of a higher appearance frequency of said keyword as a search result [note: Figure 1 310 EIT analyzer column 8 line 62 through column 9 line 19 music is detected through the content descriptor 101; also note column 10 lines 18-49 selection **frequency storing unit** for storing a selection frequency related to each topic; selector frequency assigned with ranking see column 10 lines 10-37].

12. Regarding claim 2, "said detector is configured to specify a broadcast program according to the appearance frequency of said keywords" [see: column 10 lines 18-49 selection **frequency storing unit** for storing a selection frequency related to each topic].

13. Regarding claim 4, "a search condition setting unit configured to set ... configured to transmit request information ..." [note: column 3 lines 1-9 search processing means; column 13 lines 25-39].

14. Regarding claim 5, "said hardware communication unit is configured to transmit request information ... storage device that stores broadcast content information ..." [note: column 2 lines 42-44 memory means stores program; Figure 1 (9) memory device; column 10 lines 19-50].

15. Regarding claim 6, "said hardware communication unit configured to receive electronic program listings formed by broadcast content information ..." [note: column 11 lines 5-20].

16. The limitations of claims 10 and 12 parallel system claim 1; therefore they are rejected under the same rationale.

17. Regarding claim 7, Kanemitsu teaches the following limitations: "a storage medium configured to store broadcast information" see Figure 1 (9) memory device; "a

hardware receiver configured to receive search condition information" note Figure 1 917) and processor means column 2 lines 46-67; "search means for searching" note column 3 lines 1-9; "a detector configured to detect an appearance frequency" see column 8 line 62 through column 9 line 19 music is detected through the content descriptor 101; also note column 10 lines 18-49 selection frequency storing unit for storing a selection frequency related to each topic ; and "a transmitter configured to transmit information" column 3 lines 10-17.

18. Regarding claim 8, said detector is configured to generate information to specify a broadcast program, according to the appearance frequency [see: column 10 lines 19-50].

19. The limitations of claims 10 and 12 parallel and/or are similar in scope to system claim 1; therefore they are rejected under the same rationale.

20. The limitations of claims 11 and 13 parallel system claim 7; therefore they are rejected under the same rationale.

21. Regarding claims 14 and 15, a display unit ... [note: column 8 lines 35-61 display priority associated with ranking may be defined by the end user; Figure 22 note "display" flow chart step (s16)].

Response to Arguments

22. Applicant's arguments filed January 13, 2009 have been fully considered but they are not persuasive.

In the response Applicant argued Kanemitsu does not describe searching based on keywords. In response to Applicant's argument the Examiner respectfully maintains the rejection.

Note Kanemitsu teaches a **"broadcast receiving device** which clearly indicates supplementary information transmitted along with broadcast content, and which **facilitates program search**" note abstract. "When indicating a search screen image, the topic information items are extracted from the supplementary information as search keywords and indicated to the user in the screen image" abstract. *The system has the ability to detect a frequency appearance associated with a users preference*. Note, **column 2 lines 46-58** which reads as follows:

"The broadcast receiving device of the present invention preferably includes a manipulation means for allowing a user to input his/her selection of a topic to be displayed, and changes a display priority degree stored in the memory means according to the number of times of topic selection by the user. According to this aspect, the present invention can be adapted to individual users having different values towards each topic, offering information useful for each user. This is accomplished based on the fact that typically a user of

a receiver repeatedly selects information which most highly suits his or her interests and tastes. A number of selection may favorably be expressed as a selection".

Also note, the following:

"Referring to FIG. 21, for the genre of music, **priority ranking** is **designated** in the order of song title, artist, songwriter, composer, and arranger, **according to the values** for this user. In this embodiment, a topic concerning persons appearing in a program (cast, newscaster, or weathercaster) is designated as an extended format event descriptor 102 in a plurality of genres, but the ranking for this topic differs in each genre. This is because the value of the information concerning persons appearing in a program differs depending on the genre. The number of displayed topics is determined according to the actual broadcast conditions" [See: column 8 lines 45-55].

A keyword is used to implement a search, see **column 7 lines 55-56**, which reads as follows:

" When the program search switch G5 in the screen of FIG. 13 is operated, the search screen image I (FIGS. 16-18) is indicated. A **search keyword** is designated in the **program search** screen image of FIG. 16 (the image desirably indicates all topics as keywords; scroll indication may be used when many display items exist). The **search results are indicated** in the search result

screen image shown in FIGS. 17 and 18. By highlighting the indication of the items found as a result of the search, user recognition can be facilitated".

"Individual users have different opinions regarding a value of a topic information, depending on their interests and tastes". [See: **Col. 10 lines 38-40**].

Kanemitsu provides for a detector configured to generate a ranking of broadcast programs, note *ability to select or define interest* column 9 lines 59-67, column 8 lines 35-55 and column 10 lines 38-40.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571)272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/
Primary Examiner, Art Unit 2169
February 10, 2010